



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

30874-UT

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on

12/27/06

Signature

Typed or printed
name

Jeffrey D. Myers

Application Number

09/641,031

Filed

08/16/2000

First Named Inventor

Arvind A. Raichur

Art Unit

2176

Examiner

Chau T. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 35,964

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Jeffrey D. Myers

Typed or printed name

505-998-1502

Telephone number

December 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT APPLICATION

I hereby certify that this correspondence is being sent via facsimile to 703-872-9306, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 27, 2006.


Jeffrey D. Myers, Reg. No. 35,964

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Arvind A. Raichur et al.

Serial No. 09/641,031

Filed: August 16, 2000

For: DYNAMIC INDEX AND SEARCH ENGINE
SERVER

Examiner: Chau T. Nguyen

Group Art Unit: 2176

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Review of the above-identified application prior to filing of the Appeal Brief is requested for the following reasons:

The new Examiner's attention to the application is noted with appreciation, especially in picking it up as the third Examiner concerning this matter, and in her kind extension of an interview on November 9, 2006.

Note that the current claim set may be found in the Amendment submitted with the Request for Continued Examination mailed August 26, 2005.

Turning to the most recent Office Action, the second Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Fields (and additionally Kelley with respect to claims 2-4, 10-12, and 18-20). The third Examiner adopted the same view. The rejection is traversed in that the claims simply do not read on the cited combination(s).

A concise description of the invention with an extended example is given in the Request for Reconsideration mailed September 27, 2006, on pages 2-6.

In Jacobson a user can define "region-sets" that consist of web pages on the internet (called "regions"). These region-sets can then be searched. A search of the region set would yield results that fall under the "tree" for each of the web pages in the region-set. For example, a user might set up region sets of two web sites, namely att.com/page1 and qwest.com/page2. When the user searches they will only get results that fall under the tree for these two pages (e.g., att.com/page1/result1 and qwest.com/page2/foo/result2, but not att.com/AnotherPage because it does not fall under the tree). The user can define any number of these region-sets and then can create other region-sets by performing set logic on these region-sets. For example they can have a region-set that consists of the intersection or union of two other region-sets.

Jacobson does not disclose a "hierarchical plurality of topic categories" (independent claims 1, 9, and 17).

Jacobson's region-sets are one-dimensional lists of web sites. They have no hierarchy whatsoever. Furthermore, Jacobson does not contain topic categories. The second Examiner appears to relate the region-sets to topic categories, and then attempts to relate the regions (web pages such as att.com/page1) in the region-sets to sub-topics, and then presumably relates the pages under the tree of the regions (such as att.com/page1/page2) to sub-subtopics. But this completely stretches Jacobson and the meaning of "hierarchy" and "topic categories" in a manner one of ordinary skill in the art would not understand. In fact, with its one-dimensional list of region sets Jacobson teaches away from the present invention!

The trees of the web pages or "regions" in Jacobson are not equivalent to a web index (or a hierarchical plurality of topic categories), they are merely a collection or group of multiple web sites that may or may not even relate to one another topically. One of ordinary skill in the art would not understand the web pages in a region to be a sub-hierarchy in a hierarchical plurality of topic categories.

Jacobson does not disclose a “permitting a user to specify any subset of the plurality of topic categories” (independent claims 1, 9, and 17).

In Jacobson, all a user can do is specify a region-set to search, and can create new region-sets through set logic operations. In the present invention, recall that the plurality of topic categories is hierarchical and changeable by the user. The user, by reorganizing the topic categories in the user's hierarchy, can create a topic category that can be any subset of topic categories in the hierarchy. All that Jacobson allows one to do is to create and specify subsets of its region-sets, which again are not topic categories.

Jacobson does not teach “allowing the user to rearrange hierarchicalization of one or more categories” (dependent claims 6, 14, and 22).

To repeat, the invention in Jacobson has no hierarchy of topic categories. Jacobson's region-sets are one-dimensional lists of web sites (the web sites are what are hierarchically arranged in a tree structure). Jacobson presents a flat structure that is not hierarchical in the first place.

In the present invention a user can move a sub-sub-topic to the top level and can even move the top level topic “Recreation” under “Sports >> Basketball >> Professional >> NBA” (though it may not make sense to another user). In order for this to be possible in Jacobson a user would need to be able to place the att.com/page1 web site under att.com/page1/page2/page3, which is not possible.

In Jacobson, a user can only change the region-sets (which are one-dimensional lists of web pages). In Jacobson, the user has no control whatsoever over the regions themselves. The user cannot rearrange the hierarchy (or tree structure) of the regions since the regions in Jacobson are web sites on the internet that neither the user nor the invention in Jacobson control. In other words, to give Jacobson the power that the present invention has, a user of Jacobson's invention should have the ability to re-order the pages of someone else's web site, which is obviously not contemplated in Jacobson or even possible.

Jacobson does not teach that the user may specify any subset of the plurality of topic categories (the second element of each independent claim) "at any time, whereby the link information is dynamically updated to correspond to a new subset" (dependent claims 8, 16, and 24).

In the present invention, a user customizes their web index and then the user can choose to search only that customized web index. As discussed above, Jacobson does not teach allowing a user to "specify any subset of the [hierarchical] plurality of topic categories by the user at any time."

Furthermore, the user of the present invention does not have to know that a web page exists for it to be included in their customized web index. A user does not need to keep track of whether a web site becomes obsolete. Any obsolete web site is automatically deleted from every user's web index. Furthermore, any new web site is automatically added without the user having to do the work. In Jacobson the user not only has to know of the existence of a pertinent web site for it to be added, the user has to manually add it to a region-set. If a web site in one of their region-sets becomes obsolete it is not automatically removed and any new web sites that should theoretically fall under a region-set are not dynamically added. Therefore, the region-sets of Jacobson are not dynamically updated, only the web sites contained are so updated. As a result, in Jacobson a search could very easily be conducted of obsolete web sites or fail to search web sites that should have been included in the search.

Additional Misconceptions (independent claims 1, 9, and 17).

The present Examiner during a telephone interview had other misconceptions concerning the invention that should be pointed out.

Again, the underlying problem is that the present invention is of a customizable and hierarchical index, whereas the prior art shows merely an index that is partially customizable but not hierarchical. In the prior art, what is indexed is hierarchical, but not the index itself. The primary reference teaches away from a hierarchical topic index structure by using merely a flat structure of region-sets.

The Examiner opined that a site administrator could alter an index hierarchy (for example in a prior art search engine, such as Yahoo.com), and that Applicants' invention would read on that. This

illustrates three misconceptions. First (and principally), a site administrator acting in such capacity would not be a "user" as understood by one of ordinary skill in the art. Second, the Examiner should not be using non-cited prior art in order to object to Applicants' claims. Third, the Examiner should not be rejecting a claim based upon an added reference for a single claim element, as the claim as a whole must be considered.

The Examiner also seemed of the view that the ability to pick a subset of a hierarchy to search reads on Applicants' claim element regarding specification of any subset. "Any" means "any", and anyone of ordinary skill in the art would so read it. So any applicable prior art having a hierarchical topic index such as Yahoo.com, again as yet uncited, that relates to ability to choose a single subset does not read on the ability of the user of the present invention to specify any subset of the hierarchy. All they have to do is to rearrange their hierarchy to their desire.

Neither Fields nor Kelley cure the above noted deficiencies of Jacobson. Fields relates to a hyperlinked search interface for a distributed database involving selecting a word that is then linked to search results concerning that word. Kelley relates to web page searches in which the located web pages are stored locally, including non-HTML source code. Accordingly, all claims presented are patentable.

As far as Applicants are aware, Applicants invention as claimed is still nowhere to be found on the Internet, some 7.5 years after Applicants' initial patent filing. I.e., there still are no search engines that allow users to customize their own hierarchical set of topic categories (which can be any subset, not merely a subset, of the initial set) and then search only that customized set.

Review and a direction for allowance are respectfully requested.

Respectfully submitted,

PEACOCK MYERS, P.C.

By: 

Jeffrey D. Myers
Reg. No. 35,964